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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,661	02/28/2002	Elliot Brenhouse	7190-201	2308
27383	7590	09/14/2005	EXAMINER	
CLIFFORD CHANCE US LLP 31 WEST 52ND STREET NEW YORK, NY 10019-6131			O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/086,661

Applicant(s)

Brenhouse

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on June 27, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 28, 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20020528 and 20030724.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Invention I (Claims 1-16) in the reply filed June 27, 2005 is hereby acknowledged. The traversal is on the ground(s) that applicant has now amended the claims drawn to the non-elected invention(s), such that the particular example of distinctness cited by the examiner in making the restriction, with respect to how the process as claimed could be practiced by another, materially different apparatus, or by hand, no longer applies.
2. Applicant's arguments have been fully considered but are not found persuasive.
3. Regarding the argument that the particular example of distinctness cited by the examiner no longer applies, the argument is irrelevant, since the example provided was only exemplary, and other examples exist as well. Another example of distinctness would be that the apparatus as claimed can be used to practice another, materially different process, such as a process of checking out goods having no attached security tags to be deactivated.
4. The restriction requirement is still deemed proper and is therefore made FINAL.
5. Claims 17-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed June 27, 2005.

*Drawings*

6. The drawings are objected to because Figures 1B, 2A, 2B, 2C, 2D, and 3 apparently comprise black and white photographs.

Black and white photographs are acceptable for examination purposes only, unless a petition filed under 37 CFR 1.84(b)(1) is granted permitting their use as acceptable drawings.

7. In the event that applicant wishes to have the photographs on file considered for approval as acceptable drawings, such a petition can be filed, but must be accompanied by the appropriate fee set forth in 37 CFR 1.17(i) and three sets of the photographs. The photographs must either be developed on double weight photographic paper or be permanently mounted on bristol board. The photographs must be of sufficient quality so that all details in the photographs are reproducible in a printed patent. See MPEP § 608.02 and 37 CFR 1.84(b)(1).

8. A proposed drawing correction or corrected drawings (or other appropriate corrective action) are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. No new matter should be entered.

*Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

10. Claims 1-4 and 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mason (US 6,497,361).

Mason discloses a customer self-checkout system for processing article purchases, the system comprising: a self-checkout station comprising: an input device configured to receive product code input designating an article for purchase; a deactivation device configured to produce a deactivation region effecting deactivation of a security tag attached to an article for purchase; and a prompting system configured to present a deactivation prompt to direct a user to position an article for purchase within the deactivation region to effect security tag deactivation.

Regarding claim 2, in the system of Mason the prompting system is configured to present a second prompt directing a user to enter a product code using the input device.

Regarding claim 3, the system of Mason further comprises: a target visibly disposed proximate the deactivation region at the checkout station; and wherein the second prompt instructs the user to move the article to touch the target to effect security tag deactivation.

Regarding claim 4, in the system of Mason the prompting system is configured to present the deactivation prompt after a receipt of a product code by the input device.

Regarding claim 7, the system of Mason further comprises a sensor for sensing the presence of an article within the deactivation region.

Regarding claim 8, the system of Mason further comprises: a bagging platform comprising a scale operatively coupled to the prompting system and configured to detect weight of bagged articles; and wherein the prompting system is configured to present the deactivation prompt when a weight change is detected by the bagging scale and the sensor has not sensed presence of the article within the deactivation region.

Regarding claim 9, in the system of Mason the prompting system is configured to present a prompt providing instructions to a user to place the article into a bag on the bagging platform.

Regarding claim 10, in the system of Mason the bagging platform further comprises a bag holder adapted to hold a bag for receiving articles.

Regarding claim 11, in the system of Mason the prompting system is configured to present a feedback prompt to confirm deactivation of the security tag after the sensor senses presence of an article within the deactivation region.

Regarding claim 12, in the system of Mason the feedback prompt comprises a prompt instructing the user to place the article in a bag.

Regarding claim 13, in the system of Mason the input device comprises a device selected from the group consisting of a bar code scanner, a scanner-scale module, a touch-screen display, and a keypad.

Regarding claims 14 and 15, in the system of Mason the prompt comprises an animated/audio prompt provided by an audio device.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5, 6, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason (US 6,497,361).

Mason discloses a customer self-checkout system for processing article purchases, as applied above in the rejection of claims 1 and 4 under 35 U.S.C. 102(b), but Mason fails to disclose that the database system coupled to the self-checkout station and comprising stored data identifying articles having attached security tags also stores data on articles not having attached

security tags to determine whether an article designated by the received product code input has an attached security tag; and wherein the prompting system is configured to present the deactivation prompt when the article has an attached security tag and to not present the deactivation prompt when the article does not have an attached security tag, the system of Mason presenting the deactivation prompt when the stored data associated with an article does not indicate whether said article has an attached security tag or not, since the system of Mason seems to assume that all items in the store would have a security tag needing to be deactivated.

However, it is well known to those of ordinary skill in the art, that, ordinarily, due to the cost of the security tags, not all items in a store are provided with security tags, and it would be self-evident/inherent that items not having security tags would not need to have a security tag deactivated.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Mason so as to use store in the database of item weights, an indication as to whether or not each item is protected by a security tag, and to only deactivate tags for items that have such tags, as is well known to do, in order to accommodate stores having a mix of inventory partially protected by security tags and partially not protected by security tags, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.



***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to the disclosure.
14. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

September 6, 2005

 (9-6-05)

Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627